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UNITED STATES PATENT AND TRADEMARK OFFICE

Trademark Trial and Appeal Board

In re Brownfield Realty, Ltd.

Serial No. 75/191,100

Joseph M. Konieczny of Harding, Earley, Follmer & Frailey
for Brownfield Realty, Ltd.

Naakwama S. Ankrah,¹ Trademark Examining Attorney, Law
Office 101 (Jerry Price, Managing Attorney).

Before Cissel, Seeherman and Hanak, Administrative
Trademark Judges.

Opinion by Seeherman, Administrative Trademark Judge:

Brownfield Realty, Ltd. has appealed from the final
refusal of the Trademark Examining Attorney to register
BROWNFIELD REALTY LTD and design, as shown below, for the
following services:

Real estate services, namely, the
acquisition, investment, leasing,
ownership, management, and disposition
of environmentally-impaired real estate
and debt instruments secured by
environmentally-impaired real estate
(Class 36);

¹ This Examining Attorney wrote the brief on appeal. A
different Examining Attorney examined the application.

Environmental remediation, namely, soil, waste and/or water treatment services (Class 40); and

Environmental management, namely, hazardous waste management; environmental due diligence, namely, reviewing standards and practices to assure compliance with environmental laws and regulations (Class 42).



The stippling shown around the circumference of the design element is a feature of the mark; the upper portion of the circle is lined for the color orange, and the lower portion of the circle is black.

Applicant has disclaimed exclusive rights to the term LTD., but otherwise seeks registration of this mark on the Principal Register without a disclaimer of the words BROWNFIELD REALTY. Applicant asserts that these words are inherently distinctive, and in the alternative, claims that the words have become distinctive as provided by Section 2(f) of the Act. As a further alternative claim, applicant seeks registration on the Supplemental Register without a disclaimer of the words BROWNFIELD REALTY.

The prosecution history of this application is somewhat convoluted. When applicant originally applied to register its mark on the Principal Register, the Examining Attorney required that the words BROWNFIELD REALTY LTD. be disclaimed on the ground that they are merely descriptive of applicant's services. Applicant then offered a disclaimer of the words, but amended the application to the Supplemental Register. The Examining Attorney required applicant to amend the registration from the Supplemental Register to the Principal Register, stating that because the mark was eligible for registration on the Principal Register, it could not be registered on the Supplemental Register (in effect, refusing registration on the Supplemental Register). Applicant then withdrew the disclaimer of BROWNFEILD REALTY LTD., explaining that the offer of the disclaimer was inadvertent, and maintained its request for registration on the Supplemental Register. The Examining Attorney then issued an Office action making final the requirement to amend the application to the Principal Register and to disclaim the words BROWNFIELD REALTY LTD. Applicant then filed a request for reconsideration in which it disclaimed the term LTD., argued that BROWNFIELD REALTY is not merely descriptive of applicant's services and, in the alternative, that the

wording BROWNFIELD REALTY has acquired distinctiveness. The Examining Attorney was not persuaded by the claim of either inherent or acquired distinctiveness, and the requirement for a disclaimer of BROWNFIELD REALTY was eventually made final.

In the communications regarding the alternative claim of acquired distinctiveness, neither applicant nor the Examining Attorney made any reference to applicant's previous amendment to the Supplemental Register, and it appeared that applicant had tacitly withdrawn the amendment to the Supplemental Register since applicant's claims of inherent and acquired distinctiveness of BROWNFIELD REALTY are obviously at odds with its seeking registration on the Supplemental Register. However, in applicant's appeal brief it indicates that it still seeks registration on the Supplemental Register in the alternative, and the Examining Attorney has discussed this issue in his brief.

The issues before us, then, are whether the words BROWNFIELD REALTY in applicant's mark are merely descriptive of its services and must be disclaimed, or, in the alternative, whether these words have acquired distinctiveness, or, in the alternative, whether applicant's mark is registrable on the Supplemental Register without a disclaimer of these words.

The appeal has been fully briefed,² but an oral hearing was not requested.

The key question in this appeal is whether BROWNFIELD REALTY is merely descriptive of applicant's identified services, and therefore must be disclaimed pursuant to Section 6(a) of the Trademark Act, 15 U.S.C. 1056(a). That section provides, in part, that the Director may require the applicant to disclaim an unregistrable component of a mark otherwise registrable. It is the Examining Attorney's position that the term is merely descriptive (and therefore unregistrable) because when "brownfield"--property with environmental cleanup obstacles--and "realty"--real estate--combine to form BROWNFIELD REALTY the resulting term is highly descriptive of applicant's services. In support of this position the Examining Attorney has submitted a number of excerpts of articles from the NEXIS database, including the following:³

Salt Lake City received a \$150,000
grant to boost its brownfield

² With its reply brief applicant has submitted a listing (42 applications and 8 registrations) of marks which include the word REALTY. This list is manifestly untimely and has not been considered. See Trademark Rule 2.142(d).

³ In reaching our decision herein we have not relied on the wire service reports submitted by the Examining Attorney because it is not clear whether they were used in articles that had public circulation. For similar reasons, we have not considered the articles taken from foreign papers. Even without these articles though, there are dozens of articles of record taken from papers in circulation in the United States.

restoration work and \$50,000 to preserve green space.

"The Salt Lake Tribune," April 16, 2000

...awarded Las Vegas another grant, this time for \$100,000, to begin the process of cleaning up more so-called brownfield sites.

Brownfields are industrial or commercial sites that are not contaminated to the extent that they qualify for cleanup as a Superfund site, but...

...Last year, the 4-acre armory site, tainted by hazardous waste and petroleum by-products, was the nation's first brownfield site to be restored under the EPA revolving loan fund.

"Las Vegas Review-Journal," April 15, 2000

The Environmental Protection Agency awarded a \$200,000 grant to the Downriver Community Conference Thursday to support brownfield redevelopment and greenspace initiatives. The conference can use \$150,000 to fund its program to develop under-used industrial and commercial facilities.

"The Detroit News," April 14, 2000

The General Assembly has passed so-called brownfield legislation, which allows businesses to develop abandoned sites with environmental problems and clean them up, without incurring any future liability.

"The Post and Courier" (Charleston, SC), April 14, 2000

...funds to study possible contamination at the former Connecticut Foundry Co. site.

The town may apply for a Brownfields grant from the federal Environmental Protection Agency, Mayor Donald Unwin said Friday.

"The Hartford Courant," February 15, 1997

...Gov. Tommy Thompson's proposal for the 1997-'99 budget includes \$20 million in grants to help clean environmentally contaminated properties, known as brownfields. "Milwaukee Journal Sentinel," February 14, 1997

The Lautenberg bill, named the "Brownfields and Environmental Cleanup Act of 1997," and the Republican brownfields initiative would boost environmental audits, site characterization and remediation activity at contaminated industrial sites around the country. "Real Estate/Environmental Liability News," February 7, 1997

Headline: Brownfields bill to help reuse old industrial sites; Delayed city project shows cleanup issues
Text: Nationwide, with encouragement from the Environmental Protection Agency, brownfields programs have taken off. Thirty-one states have enacted voluntary cleanup programs, the EPA says. "The Sun" (Baltimore), February 2, 1997

The term "brownfields" is defined by the state [Maryland] Department of the Environment as "abandoned or underutilized industrial or commercial properties that face environmental cleanup obstacles that would prevent their redevelopment and reuse." "The Baltimore Sun," January 27, 1997

The Examining Attorney has also made of record printouts from the United States Environmental Protection Agency website which devotes entire sections to

brownfields, with captions such as "About Brownfields," "Brownfields Projects and Initiatives" and "Other Sources of Information on Brownfields."

In addition, the Examining Attorney points to applicant's own information, some of which was submitted by applicant and some of which was taken from applicant's website and made of record by the Examining Attorney. This material includes the following statements:

If you are faced with an environmentally contaminated commercial or industrial property (a "brownfield"), but you've heard the horror stories of dealing with the EPA or state environmental enforcement agencies, we can help.

What do we do? Brownfield Realty, Ltd. will assume regulatory responsibility for the environmentally compromised property, provide funds for efficient remediation, provide environmental insurance and/or secure agency approvals necessary to return the property to profitability.

Does Brownfield Realty, Ltd. buy such properties? YES! We actively seek out properties which have existing pollution either from on-site activities or from adjacent properties.
www.brownfld.com

In addition, with his appeal brief the Examining Attorney has submitted a dictionary definition of "realty"

as meaning "real estate."⁴ We take judicial notice of this definition.⁵

A mark is merely descriptive, and therefore prohibited from registration under Section 2(e)(1) of the Trademark Act, 15 U.S.C. 1052(e)(1), if it immediately conveys knowledge of the ingredients, qualities, or characteristics of the goods or services with which it is used. **In re Gyulay**, 3 USPQ2d 1009 (Fed. Cir. 1987); **In re Engineering Systems Corp.**, 2 USPQ2d 1075 (TTAB 1986). It does not have to describe every one of these, but it is sufficient to be considered merely descriptive if it describes a single, significant quality, feature, function, etc. **In re Venture Lending Associates**, 226 USPQ 285 (TTAB 1985).

The evidence of record clearly shows that BROWNFIELD is a recognized term for contaminated land, and that applicant's real estate, environmental remediation and environmental management services all involve brownfield sites. Thus, BROWNFIELD describes a significant characteristic of applicant's services. The term REALTY also describes applicant's services, in that applicant's

⁴ The American Heritage Dictionary of the English Language, 3d ed. © 1992.

⁵ The Board may take judicial notice of dictionary definitions. **University of Notre Dame du Lac v. J. C. Gourmet Food Imports Co., Inc.**, 213 USPQ 594 (TTAB 1982), *aff'd*, 703 F.2d 1372, 217 USPQ 505 (Fed. Cir. 1983).

services involve real estate. When the words are combined as BROWNFIELD REALTY or BROWNFIELD REALTY LTD. and used in connection with applicant's identified services, the resulting terms immediately tell consumers, respectively, that applicant provides its real estate, environmental remediation and environmental management services for contaminated land and that applicant is a company that provides such services. As such, BROWNFIELD REALTY is not inherently distinctive.

Applicant argues in its reply brief that the word REALTY "suggests that applicant is a realtor, [sic] i.e., broker, of commercial or residential real estate," p. 2, but that applicant is not. However, whatever the word REALTY may suggest to applicant, the clear meaning of the word is "real estate," and applicant itself has identified its services as "real estate" services. Thus, we do not accept applicant's argument that REALTY is an inherently distinctive term for applicant's real estate services; on the contrary, the term is generic for real estate services, in the same way that "real estate" would be generic.

Applicant also points to the definition adopted by Examining Attorney of the word "brownfield" as "abandoned or underutilized industrial or commercial properties that face environmental cleanup obstacles that would prevent

their redevelopment and reuse." Applicant then recharacterizes this definition as meaning "environmentally-impaired real estate" and combines applicant's characterization of "brownfield" with the definition of "realty" as meaning "real estate" to reach the conclusion that BROWNFIELD REALTY would mean "environmentally-impaired real estate real estate." Applicant contends that this combination of definitions is redundant and nonsensical.

We are not persuaded by applicant's semantic "logic" that BROWNFIELD REALTY is inherently distinctive. Rather, consumers will immediately understand that BROWNFIELD REALTY refers to real estate that is environmentally contaminated, and that when this term is used in connection with applicant's identified services, it describes a characteristic of the services, namely that the services involve such real estate.

This brings us to applicant's first alternative position, namely, that if BROWNFIELD REALTY is not inherently distinctive, it has acquired distinctiveness. In support of this position, applicant has submitted only a declaration, dated October 18, 2000, attesting to applicant's substantially exclusive and continuous use in commerce since as early as September 1996, in other words,

for not quite a four-year period. It is noted that in the response accompanying this declaration applicant states that it is claiming use in commerce for more than five years, and therefore is entitled to the statutory presumption of Section 2(f). That section provides that "The Director may accept as prima facie evidence that the mark has become distinctive, as used on or in connection with the applicant's goods in commerce, proof of substantially exclusive and continuous use thereof as a mark by the applicant in commerce for the five years before the date on which the claim of distinctiveness is made." (emphasis added). Because applicant did not show use of the mark for the five years prior to the filing of its claim of acquired distinctiveness on October 23, 2000, it is not entitled to rely on a mere declaration as prima facie evidence of acquired distinctiveness.

Even if applicant had made the requisite five years use, we would not have found the term BROWNFIELD REALTY to have acquired distinctiveness. It is the applicant's burden to prove that its mark, or in this case the term which for which a disclaimer has been required, has acquired distinctiveness. The greater the descriptiveness of the term, the greater the evidence necessary to prove acquired distinctiveness. See **Yamaha International Corp.**

v. Hoshino Gakki Co., 840 F.2d 1572, 6 USPQ2d 1001 (Fed. Cir. 1988). In view of the highly descriptive nature of BROWNFIELD REALTY for applicant's identified services, a mere declaration of four (or even five) years of substantially exclusive and continuous use of the mark in commerce is insufficient to demonstrate that the term has acquired distinctiveness.

This brings us to applicant's second alternative position, that its mark is registrable on the Supplemental Register. The Examining Attorney has essentially refused registration on this register (by requiring that applicant amend its application to the Principal Register) because a mark which is registrable on the Principle Register may not be registered on the Supplemental Register. The Examining Attorney asserts that, because applicant's mark is registrable on the Principal Register with a disclaimer of BROWNFIELD REALTY LTD., it may not be registered on the Supplemental Register.

The Examining Attorney has cited Section 1141.01 of the Trademark Manual of Examining Procedure in support of his position. That section states that "A mark which is clearly eligible for the Principal Register may not be registered on the Supplemental Register. An application requesting registration of such a mark on the Supplemental

Register must be amended to the Principal Register, or refused registration.”⁶ We also note that Section 23 of the Trademark Act, 15 U.S.C. 1092, states that “All marks capable of distinguishing applicant’s goods or services and not registrable on the principal register herein provided ...may be registered on the supplemental register....” (emphasis added).

Although marks which are registrable on the Principal Register may not be registered on the Supplemental Register, the present case presents us with an odd situation, in that the Examining Attorney is requiring that, to be registrable on the Principle Register, all the wording in the mark must be disclaimed. Essentially, the Examining Attorney has found that the relatively minor design element is enough to “carry” the mark and justify its registration on the Principal Register, although the dominant part of the mark is unregistrable.

We do not think this is a correct interpretation of the statute or the Manual or the case law. The entire mark applicant is seeking to register is clearly not registrable

⁶ This statement is taken from the edition of the Manual which was in effect at the time the Examining Attorney’s brief was filed. A third edition of the Manual has now been released, and contains, in Section 815.01, essentially the same statement, except that the citation to **In re U.S. Catheter & Instrument Corp.**, 158 USPQ 54 (TTAB 1968), has been deleted.

on the Principal Register; it is only if applicant disclaims the dominant portion of the mark that it would be considered registrable. To put it another way, the Examining Attorney has found, and we agree, that the dominant part of the mark, the words BROWNFIELD REALTY LTD., is unregistrable on the Principal Register. In these circumstances, we find that applicant's mark is entitled to registration on the Supplemental Register, despite the fact that it would also be registrable on the Principal Register with a disclaimer of all the wording.

However, even marks which are registrable on the Supplemental Register may not contain generic terms unless those terms have been disclaimed. See **In re Carolyn's Candies, Inc.**, 206 USPQ 356 (TTAB 1980) and cases cited therein. The term REALTY in applicant's mark is generic for applicant's real estate services. As noted previously, REALTY is another word for "real estate," and applicant's services in Class 36 are clearly identified as real estate services. Accordingly, the refusal of registration must be affirmed absent a disclaimer for this word. However, because the word REALTY is generic only with respect to the services in Class 36, applicant may obtain a registration without a disclaimer if it divides the application to sever Classes 40 and 42 from the Class 36 application.

Decision: The refusal to register the mark on the Principal Register pursuant to Section 6 absent a disclaimer of BROWNFIELD REALTY is affirmed because the term is merely descriptive and has not acquired distinctiveness is affirmed; the refusal to register the mark on the Supplemental Register is also affirmed. However, applicant is allowed 30 days in which to submit a disclaimer of BROWNFIELD REALTY, in which case this decision will be set aside, and the mark will proceed to publication for registration on the Principal Register; or applicant may submit a disclaimer of REALTY and the application will proceed to registration on the Supplemental Register; or applicant may submit a request to divide the application, and enter a disclaimer of REALTY with respect to the Class 36 application. In that event, the application in Classes 40 and 42 will proceed to registration on the Supplemental Register without disclaimer and the application in Class 36 will proceed to registration on the Supplemental Register with a disclaimer of REALTY.